

REMARKS

As explained below, the references upon which the examiner relied when rejecting the pending claims, i.e., the Cox and Grill et al. patents, are not prior art against which those claims' semiconductor devices may be evaluated. For that reason, applicants respectfully request the examiner to allow claims 13-23 to issue.

Objection to the specification

The examiner objected to the title and the abstract for not clearly indicating the invention to which the claims are directed. The title and the abstract have been amended to specify a semiconductor device -- not a method for making a semiconductor device. Given these amendments to the title and the abstract, applicants respectfully request the examiner to withdraw the objections to the specification.

Rejection Under 35 U.S.C. §102(e) Based on Cox

The examiner rejected claim 13 under 35 U.S.C. §102(e) as being anticipated by Cox. The patent application for the Cox patent was filed October 21, 1999. Because applicants are entitled to a date of invention prior to that filing date, that patent does not have prior art status under 35 U.S.C. §102(e) with respect to pending claim 13. For that reason, the examiner cannot rely upon Cox to reject that claim under 35 U.S.C. §102(e).

An applicant can submit an appropriate oath or declaration to overcome a patent, upon which a rejection under 35 U.S.C. §102(e) is based. An applicant can overcome such a patent by showing conception of the invention prior to the

effective date of the reference coupled with due diligence from prior to that effective date to the filing of the patent application. 37 C.F.R. §1.131 and MPEP 715.

Accompanying this response are the Declaration of Qing Ma Under 37 C.F.R. §1.131 ("Ma Declaration") and the Declaration of Mark V. Seeley Under 37 C.F.R. §1.131 ("Seeley Declaration"). Those declarations establish conception of the claimed invention prior to Cox's October 21, 1999 filing date. In addition, they establish due diligence from prior to that date to the application's filing date.

Concerning conception, Mr. Ma and the co-inventors for the invention that claim 13 specifies described their invention in an invention disclosure that is dated October 4, 1999. In that invention disclosure, the inventors described a multilayer laminate for use in a semiconductor device. The invention disclosure illustrated a two layer laminate that included a carbon doped oxide layer and a tougher film that was under compressive stress such as silicon dioxide or silicon nitride, and illustrated a four layer laminate that included a first carbon doped oxide layer, a first thin coating of the tougher film, a second carbon doped oxide layer, and a second thin coating of the tougher film. (See Ma Declaration ¶ 2 and the accompanying Exhibit A.)

The Ma Declaration and accompanying exhibit thus establish conception of the claimed invention no later than October 4, 1999. Concerning due diligence, the Intel legal department received the invention disclosure no later than November 15, 1999. (See Seeley Declaration ¶ 2 and the accompanying Exhibit A.) The invention disclosure was assigned to an Intel invention review

committee for evaluation. After meeting to review that invention disclosure, along with many others, the committee authorized the filing of a patent application for the invention. (See Seeley Declaration ¶ 3.)

The application was assigned to Mr. Seeley for drafting. After receiving the file, Mr. Seeley began drafting a patent application for the invention described in the invention disclosure. After the inventors concluded that a draft accurately and completely described their invention, they signed Declaration and Power of Attorney forms, and assignments, and forwarded those documents to Mr. Seeley. (See Ma Declaration ¶ 4 and Seeley Declaration ¶ 4.)

After receiving those documents, Mr. Seeley had the patent application filed on March 14, 2000, constructively reducing to practice the claimed invention. (See Seeley Declaration ¶ 5.) The Ma Declaration and Seeley Declaration, and the accompanying exhibits, thus establish due diligence from no later than October 4, 1999 through to the constructive reduction to practice of the claimed invention on March 14, 2000.

Because applicants are entitled to a date of invention no later than October 4, 1999, the examiner cannot rely upon Cox to support a rejection of pending claim 13 under 35 U.S.C. §102(e). Consequently, applicants respectfully request the examiner to withdraw the rejection of that claim based upon that reference.

Rejection Under 35 U.S.C. §103(a) Based on Cox in view of Grill et al

The examiner rejected claims 14-17 under 35 U.S.C. §103(a) as being unpatentable over Cox in view of Grill et al. The examiner cannot rely upon either Cox or Grill et al. to support a rejection under 35 U.S.C. §103(a). As

explained above, the Cox patent does not have prior art status under 35 U.S.C. §102(e). As a result, the examiner cannot properly rely upon that reference to support a rejection under 35 U.S.C. §103(a).

The examiner cannot rely upon Cox to support the rejection of claims 14-17 under 35 U.S.C. §103(a) for another reason. The patent attorney who drafted the pending application also drafted the application that issued as the Cox patent. Both Cox and the pending application were, at the time the invention was made, subject to an obligation of assignment to the same “person” – namely Intel Corporation. (See Seeley Declaration ¶6.) 35 U.S.C. §103(c) provides:

Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Because Cox and the inventions of claims 14-17 were, at the time the inventions were made, subject to an obligation of assignment to the same “person”, the examiner cannot rely upon Cox to support a rejection of those claims under 35 U.S.C. §103(a).

Nor may the examiner rely upon Grill et al. to support the rejection of claims 14-17. The patent application that issued as the Grill et al. patent was filed May 13, 2002 as a division of an application that was filed August 31, 2000. The pending application was filed January 2, 2002 as a division of an application (serial no. 09/524,766 -- now U.S. Patent No. 6,362,091) that was filed March 14, 2000. Applicants amended the pending application to contain a specific reference to that earlier filed application and are thus entitled to the benefit of

that previous application's March 14, 2000 filing date under 35 U.S.C. §120. Because claims 14-17 are entitled to a filing date that precedes the effective filing date for the Grill et al. patent, the examiner may not rely upon that reference to support a rejection of those claims under 35 U.S.C. §103(a).

Because neither Cox nor Grill et al. constitute prior art with respect to pending claims 14-17, the examiner cannot properly reject those claims based upon a combination of those references. Consequently, applicants respectfully request the examiner to withdraw the rejection of claims 14-17 based upon the combination of Cox and Grill et al.

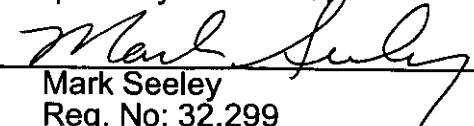
Rejection Under 35 U.S.C. §103(a) Based on Cox

The examiner rejected claims 18-23 under 35 U.S.C. §103(a) as being unpatentable over Cox in view of various remarks. As explained above, the examiner cannot rely upon Cox to support a rejection under 35 U.S.C. §103(a) because (1) the Cox patent does not have prior art status under 35 U.S.C. §102(e) given applicants' earlier invention date, and (2) Cox and the inventions of claims 18-23 were, at the time the inventions were made, subject to an obligation of assignment to the same "person" – Intel Corporation. Because the examiner cannot properly rely upon that reference to support a rejection under 35 U.S.C. §103(a), applicants respectfully request the examiner to withdraw the rejection of claims 18-23 based upon Cox in view of the presented remarks.

Because neither of the cited references have prior art status with respect to the semiconductor devices of pending claims 13-23, applicants respectfully request the examiner to withdraw the rejections of those claims that are based upon those references and to allow those claims to issue.

Respectfully submitted,

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Mark Seeley
Signature

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Date